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BEFORE THE BOARD OF PATENT APPEALS
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Appellant(s): James H. Alleman

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Daniel J. Kluth
For Appellant

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GROUP 260

EXAMINER'S ANSWER

This is in response to appellant's amended brief on appeal filed April 24, 1995.

(1) *Status of claims.*

The statement of the status of claims contained in the brief is correct.

In simple words, claims 18-27 are the subject of appeal. A clean copy of the claims is provided in Appendix D.

(2) *Status of Amendments After Final.*

No amendment after final has been filed because there has been no FINAL rejection. Applicant submitted, with this brief, an amendment cancelling claim 1. This amendment has been entered.

(3) *Summary of invention.*

The summary of invention contained in the brief is correct.

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(4) *Issues.*

The appellant's statement of the issues in the brief is correct.

(5) *Grouping of claims.*

Appellant's brief includes a statement that claims do not stand or fall together and provides GENERIC and CONCLUSARY arguments for supporting the statement.

(6) *Claims appealed.*

The copy of the appealed claims contained in Appendix D to the brief is correct.

(7) *Prior Art of record.*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

(a) **Business Week articles** entitled "Rome To Bonn Via New Jersey" (April 13, 1992) and "How Overseas Callers Can Get Stateside Rates" (December 2, 1991).

(b) US Patent 4,086,438 **Kahn et al** 4/1978

(c) US Patent 4,769,834 **Billinger et al** 9/1988

(d) US Patent 5,185,782 **Srinivasan** 2/1991

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(8) *New prior art.*

No new prior art has been applied in this examiner's answer.

(9) *Grounds of rejection.*

The following grounds of rejection are applicable to the appealed claims.

Claim Rejections - 35 USC § 112

Claims 18 - 27 are rejected under 35 U.S.C. § 112, second paragraph.

In claim 18, lines 4 and 6, "caller information" should be --subscriber information-- because the system stores information about "subscribers" only and it does not store information about every "caller" including those who may call the system by dialing the wrong telephone number. In line 22, the term "the subscriber remote telephone number" lacks clear antecedent basis because the claim previously recites (line 7) "a subscriber telephone number" without the use of "remote". It is not clear as to what is meant by "connecting to the subscriber telephone station". Which component of the system is being connected to the subscriber telephone station?

In method claim 23, it is not clear as to what is meant by "connecting to the subscriber telephone station". What is being connected to the subscriber telephone station?

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Dependent claims 19-22 and 24-27 are rejected because they depend from rejected claims 18 and 23, respectively.

Claim Rejections - 35 USC § 102

Claims 18 and 23 are rejected under 35 U.S.C. § 102(a) as being anticipated by the IDT machine disclosed in Business Week articles and admitted by applicant as Prior Art.

The article entitled "Rome to Bonn via New Jersey" (April 13, 1992) states that a subscriber can call the IDT machine in the U.S. from a foreign country, hang up and wait for the IDT machine to call him/her back so that the subscriber can make outgoing calls utilizing the IDT machine and thus pay at US rates.

The article entitled "How Overseas Caller Can get Stateside Rates" (Dec. 2, 1991) states that an overseas subscriber can call the IDT machine in the U.S. and hang up before it answers. Then the IDT machine calls back the subscriber and provides him/her with a second line to make outgoing calls.

In the specification (pages 3-4), applicant admits that in the above IDT **Prior Art** system

"an input line is dedicated to a particular user. That is for each subscribing user there is a unique dedicated input line.

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When the user calls into the system on that line, typically allowing it to ring once, the system employs an autodialer configuration to call the user who responds by entering the desired [destination] number. The system dials that [destination] number on another line then bridges the user with it upon response by the called party."

The IDT machine is not shown to contain specific components such as the claimed "control means", "storage means", telephone exchange and trunk line, however, such components are INHERENT in the IDT machine. For example, the machine inherently has to have control means, the called and calling stations inherently have to be connected by a telephone exchange and the machine inherently comprises a storage means for storing subscriber information such as the subscriber's telephone number which is needed to call back the subscriber.

Claim Rejections - 35 USC § 103

Claims 18 and 23 are also rejected under 35 U.S.C. § 103 as being unpatentable over the IDT machine disclosed in Business Week articles and admitted by applicant as Prior Art.

As discussed above, while the IDT machine performs the functions of the claimed invention, the IDT machine is not shown to contain specific components such as the claimed "control means", "storage means", telephone exchange and trunk line. If

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the use of the above components was not inherent, then it would be extremely obvious for one of ordinary skill in the art to utilize an exchange for connecting the calling and the called party, utilize a control means for controlling the IDT machine and utilize a storage means for storing the subscriber telephone number so that the IDT machine can call back the subscriber.

Claims 19-22 and 24-27 are rejected under 35 U.S.C. § 103 as being unpatentable over the IDT machine disclosed Business Week articles and admitted by applicant as Prior Art.

The above Prior Art IDT machine does not provide an indication (announcement) of an invalid call if the incoming call does not terminate within a predetermined period of time or if an incorrect DID¹ is provided by the caller.

The use of announcements in the IDT machine is inherent or extremely obvious because the machine calls back the subscriber to request the subscriber to provide a destination telephone number. This inherently or most obviously is carried out by an Audio Response Unit ARU which prompts the subscriber for information. The ARU is notoriously well known in the art and admitted by appellant on page 3 of the specification to be prior

¹Direct Inward Dial number which is provided by the telephone company to indicate to the system which number was **called** (dialed) by the calling party.

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art. One of ordinary skill in the art would not expect the IDT machine to call back the subscriber and provide SILENCE, one would expect the IDT machine to provide voice prompts or announcements.

As for announcing an invalid call attempt as recited in the claims, in the above IDT system, each subscriber has a unique dedicated input line and the subscriber must hang up after one ring. If, for example, a calling party does not hang up after one ring (the call does not meet the requirement), this of course would be considered an invalid call attempt and the designer of the system can choose how to handle such invalid calls. For example, the designer can choose to provide an announcement to the calling party. Many announcements have been used in the art such as "... *your call can not be completed* ...". Similarly, it would have been obvious to indicate an invalid call attempt if the input provided by the calling party does not match a prestored input. This is analogous to "... *the account number you have entered is not valid*...". Numerous references such as the references cited by appellant on pages 2-3 of the specification teach the use of the well known audio response unit for making announcement to the calling party. Thus, the use of an indication (announcement) for invalid call attempts is well known and does not rise to the level of patentability.

Claims 18-27 are rejected under 35 U.S.C. § 103 as being unpatentable over Kahn et al in view of Billinger et al and further in view of Srinivasan.

Kahn et al discloses an automatic interconnection system 30 for answering incoming calls and connecting the incoming call to an outgoing line for making an outgoing call. The calling party has to provide a security code which will be compared with stored codes by security code circuit 200. If a valid security code is entered by the calling party, the system will provide the calling party by a dial tone so that the calling party can make outgoing (local/long distance) calls.

The reference teaches that the calling party can call the system, dial his/her number and then hang up. In this case the system will initiate a call-back to the calling party after which a dial tone will be provided to that party to make outgoing calls using the system.

The reference differs from the claims in that in the reference (filed March 1977), in order to call back the subscriber, the reference answers the call and the subscriber manually provides a security code. In the claimed invention, the subscriber can be called back by using information provided automatically by the telephone company (such as the DID) and without answering the call.

The use of information provided automatically by the telephone company to identify the calling party without answering

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the call instead of answering the call and waiting for the calling party to manually enter a security code is clearly and explicitly taught by **Billinger et al.** The **Billinger et al** reference explicitly teaches the use of information provided automatically by the telephone company (such as ANI²) to eliminate the need for the calling party to dial an authorization code. Using ANI instead of authorization call means that the calling party can be identified without answering the call (free call). Utilizing the ANI also provides advantages such as speed and accuracy because having the calling party manually enter his/her number may cause delay and sometimes the calling party may make a mistake while entering the number. In general, providing a number automatically is preferred over providing the number manually. Further, the calling party can be identified without having the calling party pay for the call.

Thus, while updating the **Kahn et al** system to meet the current technological standards as disclosed in **Billinger et al**, it would have been obvious to utilize the information provided automatically by the telephone company (ANI) to automatically identify the originating station.

²Automatic Number Identification is used by the telephone company to automatically inform the system with the number of the calling party.

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The information provided automatically by the telephone company can be either the ANI or the DID. The telephone company uses the ANI (Automatic number identification) to automatically inform the system of the calling party telephone number and it also uses the DID (direct inward dialing) to automatically inform the system of the called number that was dialed by the calling party. The system can automatically receive both the ANI and DID without having to answer the call. The DID is sometimes referred to as DNIS (Dialed Number Identification Service). **Numerous references**, such as the **Srinivasan** reference, teach the use of the well known ANI and DID/DNIS in telecommunication services. It is well established in the art that the ANI and DID which are automatically provided by the telephone company can be used in order to provide the desired services to the calling parties³.

In view of the above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the DID or the ANI in order to identify the calling party and decide how to handle the call. The use of the DID instead of the

³**Inbound/Outbound Magazine** (October 1989 and May 1990) teaches the use of ANI and DNIS/DID in telecommunication systems. **Richardson, Jr. et al** (US Patent 5,317,627) teaches the use of DNIS [DID] tables in order to provide various applications after comparing the incoming DNIS [DID] number with prestored DNIS [DID] numbers. **Katz** (US Patent 5,218,631) teaches that calls are conditionally accepted based on a test of preliminary identification data ANI or DNIS.

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ANI is advantageous because the ANI may not be available for some long distance calls and international calls.

As for announcing an invalid call attempt, as discussed in detail above, the use of announcements is well known and does not rise to the level of patentability.

(10) *New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

(11) *Response to argument.*

Rejection of claims 18 and 23 under 35 USC § 112.

(A) The brief incorrectly states (page 5) that the rejection "IS BASED, IN PART, ON THE INCORRECT VERSIONS OF THE CLAIMS."

The previous Office action (paper # 26, 1/25/95) included rejection of claim 1. Appellant mistakenly thought that claim 1 was previously cancelled and concluded that the rejection was based on an incorrect version of the claims. Appellant submitted with the amended brief, an amendment (paper # 29) cancelling claim 1. Rejections of claim 1 are now MOOT.

(B) Appellant's arguments regarding the rejection of claims 18 and 23 do not clarify "the language of the claims".

Claim 18 recites (lines 4-7) "... a database of caller information ..." (two occurrences) and then the claim refers repeatedly to the "subscriber". The rejection indicates that "caller information" should be --subscriber information--. Appellant argues that a caller becomes a subscriber after verifying the DID number. This explanation does not clarify the language of the claims because the claim clearly recites "... managing a database of **caller** information" and "... storing the database of **caller** information including a preassigned direct inward dial telephone number associated with a **subscriber** and a **subscriber** telephone number associated with the **subscriber** telephone station" [emphasis added]. According to the disclosure and the claims, the database stores "subscriber" information such as the telephone number of the subscriber. The database does not store "caller" information. For example, if a caller is not a subscriber, the database will NOT have the caller's telephone number. Again, reciting "database of caller information" is confusing and incorrect because the database does not store the telephone number of every caller that may call the system by dialing the wrong telephone number. The database stores ONLY subscriber information.

The rejection indicates that the expression "the subscriber remote telephone number" (line 22 of claim 18) lacks clear antecedent basis because line 8 refers to "the subscriber telephone number" (without "remote"). Appellant argues that when the number is stored, it is referred to as "the subscriber telephone number" but when the number is called, it is referred to as "the subscriber remote telephone number" because the subscriber is remote from the system. Examiner respectfully disagrees with appellant. The same entity (the subscriber telephone number) can not be arbitrarily referred to by different expressions based on how this entity is being used. One expression should be used for the same entity. For example, what is being stored is "the subscriber telephone number" and what is being called is also "the subscriber telephone number". The terminology should be consistent when referring to the same exact entity to avoid confusion.

In claim 18, the system comprises many components such as "control means", "first telephone connection means" and "second telephone connection means", yet the claim simply recites (lines 23-24) "connecting to the subscriber telephone station" without indicating what is being connected to the subscriber station. Generally speaking, in English, stating "... connecting to B" would be awkward and unclear unless TWO entities are mentioned.

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"Connecting A to B" is appropriate and clear. Appellant simply argues on page 6 of the brief that the connection is between THE SYSTEM and the subscriber. Since the system comprises many components with different functions, argument such as "connecting the system" (which is not even recited in the claim) is not convincing.

In method claim 23, "connecting to the subscriber telephone station" is considered vague and indefinite because it is not clear as to what is being connected to the subscriber telephone station. Appellant's argument that the SYSTEM is connected to the subscriber station is baseless because there is NO system in method claim 23.

Rejection of claims 18 and 23 under 35 USC § 102 based on IDT machine

(A) The prior art is the IDT machine not the Business Week articles.

Appellant states (page 6) that the Business Week articles are not prior art. The rejection is based on the IDT machine which is (a) admitted in the specification as prior art, (b) disclosed in the Business Week articles and (c) disclosed in other documents including the article in The Economist magazine

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submitted by appellant. Thus, the prior art is NOT the Business Week articles, *per se*, the prior art is the IDT machine.

(B) The IDT machine is CLEARLY admitted in the specification as PRIOR ART.

ART.

Under description of the prior art (pages 1-4 in the specification), the IDT machine is clearly admitted as PRIOR ART. Starting on page 3, line 23, the specification states

"The prior art has also recognized"

"Thus, a system was developed In the prior art system, an input ..."

"..., the system employs autodialer configuration to call..."

"The system dials that number ..."

"The aforementioned system can likewise ..."

*"Such a system is described in the January 9, 1992 New York Times article entitled
Hot-Wiring Overseas Telephone Calls"*

The New York Times article describes the system introduced by International Discount Telecommunications (**IDT**). From the above, it is clear that the specification refers to the IDT machine as PRIOR ART. Such admission of prior art can be used to reject the claims. It was held that any statement by applicant in the application that a certain matter is "prior art" to him, is an admission that the matter is prior art for all purposes, whether

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or not a basis in 35 USC §102 can be found for its use as prior art, see In re Nomiya, 184 USPQ 607.

On pages 8 and 9 of the brief, appellant alleges that pages 3 and 4 of the specification refer to appellant's prior development and states that "*the disclosure on pages 3 and 4 does not relate to the IDT machine*". Examiner respectfully disagrees because this clearly contradicts the explicit and unquestionable admission of prior art as discussed above. The language in the specification undoubtedly admits that the IDT system is prior art.

(C) Besides being described in the New York Times article, the IDT machine is described in the Business Week articles and The Economist article.

The Business Week Articles dated April 13, 1992 and December 2, 1991 describe the IDT machine. The Economist (September 12, 1992) discusses international call back services and states on column 2 that :

"One of the best known discounters, 2 1/2 year old International Discount Telecommunication (IDT), uses third-country calling to provide calls between countries".

Thus, according to this reference which was submitted by appellant, on September 12, 1992, the IDT machine was 2 1/2 years

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old. This means that the IDT machine (which is also admitted by appellant as prior art) was built and used in the U.S. on or before March 12, 1990. Again, the articles submitted by appellant and appellant's own specification support the examiner's position in considering the IDT machine as prior art.

(D) The declaration under 37 CFR 1.131 is insufficient to overcome the rejections based on the IDT machine.

First, appellant has admitted on pages 3 and 4 of the specification that IDT machine is prior art and thus the rejections based on the IDT machine may not be antedated by appellant's declaration.

Second, the Economist article which is submitted by appellant provides evidence that the IDT machine was made and used in the US on or before March 12, 1990 (more than ONE year before the effective filing date of this application which is 4/24/92). That is a STATUTORY BAR date under 102(b) which may not be antedated.

Third, it is not clear from the declaration as to what the conception date is. The declaration refers to using the "stand-alone box" then the DID. The declaration refers to "quality improvements" (page 3 of the declaration) and it states (page 4) that "the present invention continued to be non-functional". Thus

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appellant "conception" is NOT a clear and defined idea of a complete and operative invention.

Fourth, no evidence such as sketches, models, notebooks or blue prints have been submitted.

Fifth, since appellant is now, for the first time, attempting to swear behind the admitted prior art (IDT machine), examiner is providing evidence indicating that the IDT machine is indeed prior art, see Exhibit E1, if needed. Examiner's evidence in Exhibit E1 clearly shows public use one year before the effective filing date of this application (April 24, 1992) and thus the IDT machine has 102(b) date [**STATUTORY BAR**] and may not be antedated by a 1.131 declaration.

(E) The Business Week articles provide a person SKILLED in the art with an enabling disclosure.

Appellant argues that the Business Week articles fail to provide an enabling disclosure for purposes of 35 USC 102(a).

First, the rejection is based on the IDT machine which is not only described by the Business Week articles, but also admitted by applicant as Prior Art, discussed in appellant's specification and discussed by the New York Times article.

Second, the IDT machine which has been used in this country is functional and the description provided about the IDT machine is sufficient for the SKILLED artisan to make and use the

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machine. The IDT machine calls back the subscriber, the SKILLED artisan would know that the IDT machine must inherently have a database of subscriber information containing the subscribers' telephone numbers. The IDT machine calls back the subscriber, the SKILLED artisan would know that an autodialer ("control means .. for calling the subscriber ...") is needed to automatically call back the subscriber. Appellant admits (page 4, line 4 of the specification) to the use of the autodialer in the IDT machine. The IDT machine prompts the subscriber to provide the destination number, the SKILLED artisan would know that an Audio Response Unit (which is well known and admitted by appellant on page 3 of the specification) is needed for prompting the subscriber. Bridging the two calls (conference call) has been known and used for many years and the SKILLED artisan would be able to have the machine set up a conference call. In brief, the main components needed to make the machine, in examiner's opinion, are computer for storing information and controlling the operation, an ARU for prompting the subscriber and an autodialer for calling the subscriber. Again, the description of the IDT machine does not include any new communication principles, on the contrary, the description of the IDT machine teaches how well known techniques can be used in the described manner to provide the call back service.

Rejection of claims 18 and 23 under 35 USC § 103 based on IDT machine

Establishing a prima facia case of obviousness does not necessarily require the reference to disclose ALL the claimed elements as alleged by appellant.

Appellant argues (page 9 of the brief) that the Business Week articles fail to disclose all of the elements of the claimed invention and therefore, no prima facia case of obviousness has been set forth. Appellant appears to confuse the rejection under 35 USC 102 with the rejection under 35 USC 103. A 103 reference need not explicitly disclose all the claimed elements. The above rejection clearly states that incorporating elements which are not explicitly disclosed such as a control means and storage means in the reference would have been extremely obvious and necessary for the functions described by the reference to be carried out.

Rejection of dependent claims under 35 USC § 103 based on IDT machine

Appellant's generic arguments are not well founded.

Appellant repeatedly argues that "there is no disclosure for ... , therefore, no prima facia case of obviousness is set forth". First, a 103 reference

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need not explicitly disclose all the claimed means. Second, the means which are not explicitly disclosed by the reference are extremely obvious (if not inherent). For example, the reference teaches "prompting" the subscriber for the destination number, thus the use of Audio Response Unit (ARU) is inherent, or at least, extremely obvious. As for the announcement indicating an invalid call, the art is replete with messages such as *"your call can not be completed as dialed ..."*, *"the number you have dialed is not in service..."*, *"the account number you have entered is not valid"....etc.* Thus incorporating an announcement indicating an invalid call attempt in the ARU would have been extremely obvious.

Rejection based on Kahn in view of Billinger and Srinivasan

The claimed use of ANI has been cancelled (claim 1) by the amendment submitted with the brief.

On page 12 of the brief, appellant refers to page 8 of the previous Office action and states that the claims are PRESENTLY limited to the direct inward dial (DID) number. Again, claim 1 always recited the use of the **ANI** as one embodiment in this application. This is why the previous office action addressed the use of the **ANI**. Now and only now, appellant is canceling claim 1

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which recites the use of the ANI and appellant now is arguing the difference between the DID and the ANI. The fact that both the ANI and the DID have been used in this application as different embodiments clearly supports the examiner position which is basically considering the use of **DID** an equivalent or alternative for the **ANI**.

The art rejection as discussed in detail above shows that in the **Kahn et al** system (filed 1977), the subscriber calls the system, the system answers the call, the subscriber manually enters a number, hangs up then the system calls the subscriber back to set up a conference call.

The **IMPROVEMENT** is suggested by **Billinger et al** which teaches the use of ANI instead of a security code so that the system will receive the identification automatically and without answering the call.

The DID is shown as an **EQUIVALENCE** or **ALTERNATIVE** for the ANI as suggested by many references such as **Srinivasan**. The artisan would be motivated to use the DID instead of the ANI because some long distance calls or international calls may not provide the ANI to the system.

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Conclusion

The IDT machine is indeed prior art as admitted by appellant and as demonstrated by evidence. The components of the IDT machine are either inherent (102 rejection) or at least extremely obvious (103 rejection). Appellant can not now withdraw admission of prior art by submitting a declaration attempting to swear behind the IDT machine. Besides being admitted as prior art, the evidence clearly demonstrates that the IDT machine has been built and used more than ONE YEAR prior to the effective filing date of this application (STATUTORY BAR).

In the rejection based on Kahn, Billinger, and Srinivasan, the Kahn reference teaches the call-back feature. Billinger explicitly teaches the IMPROVEMENT of automatically using the ANI without answering the call. Srinivasan suggests that the DID and ANI are EQUIVALENT or PARALLEL to each other. Thus, IMPROVING the Kahn system as suggested by Billinger and using an EQUIVALENT or PARALLEL approach as suggested by Srinivasan would have been obvious to one of ordinary skill in the art telephonic communication.

In view of the above, it is believed that above rejections should be sustained.

Respectfully submitted

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